



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/469,637	06/06/98	GREENE	1408-0710001

HM11/1124
STERNE KESSLER GOLDSTEIN & FOX
1100 NEW YORK AVENUE N W
SUITE 600
WASHINGTON DC 20005

EXAMINER
PAK, M.

ART UNIT	PAPER NUMBER
1846	

DATE MAILED: 11/24/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/469,637

Applicant(s)
Greene et al.

Examiner
Michael Pak

Group Art Unit
1646



☒ Responsive to communication(s) filed on Sep 3, 1998

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 31 and 36-85 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 31, 36-59, 68, 69, and 80-85 is/are allowed.

☒ Claim(s) 60-67 and 70-79 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 27

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Response to Amendment

1. Amendment filed 3 September 1998, Paper No. 26, has been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Applicants arguments have overcome the rejection for new matter under 35 U.S.C. 112, first paragraph, discussed in the last office action.
4. Applicant's arguments filed 3 September 1998, Paper No. 26, have been fully considered but they are not found persuasive.

Information Disclosure Statement

5. Applicants resubmission of supplemental information disclosure statement filed 3 September 1998, Paper No. 27 has been considered in part.

As indicated in the previous office actions the information disclosure statement references AS11-18, AR12-18, and AT11-17 copy of the sequence listing contains sequence comparisons without an explanation of the relevance of the disclosure. Applicants argue that there is no requirement for the

"information" to be in a particular form in the MPEP and an explanation of the relevance is required for information listed which is not in English language. Examiner is of the position that DNA sequences do not fall under the heading of an English language and requires some type of explanation. However, the database information has been examined to the extent possible without an explanation of the relevance of the sequences.

As indicated in the previous office actions, the information disclosure statement references AS18, AT18, and AR19, are search reports which are part of the foreign patent documents. It is not possible to examine the search reports in vacuum without the full PCT publication including the patent. When listed under the heading of the foreign patent documents of the IDS, the WO patents include the attached search report. The references have been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Claim Rejections - 35 USC § 112

6. Claims 66-67, 70, 72-79 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 66-67, 70, and 72-79 are directed to specific species of polynucleotide encoding a polypeptide fragment of 30 or 50 amino acids which are not supported in the specification. Page 10, second paragraph, discloses the nucleic acids for hybridization and the specific species of specific sized polynucleotide fragments but not the polypeptide fragments of 30 or 50 amino acids.

7. Claims 60-67 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 60 recites the limitation "the same polypeptide" and "the cDNA" in limitation (a). There is insufficient antecedent basis for these limitations in the claim. Claims 61-67 are dependent on claim 60 with specific reference to limitation (a)

or encompass the limitation of claim 60(c).

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(f) he did not himself invent the subject matter sought to be patented.

9. Claims 60-67 rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter.

The specification on page 36, line 11-13, teach that the deposit vector is composed of pQE9 and the cDNA sequence of interest. Since the vector synthesizes the antibiotic resistance (Ampr) protein when expressed in the cells, it meets the limitations of claim 60-63 which are directed to any protein encoded by the cDNA of the deposited plasmid. The pQE9 is made and sold by Qiagen, Inc. The pQE9 inherently comprises the specified fragment sizes of the claim limitations of claims 64-67 because pQE9 contains the full length sequence.

10. Claims 31, 36-59, 68-69, and 80-85 are allowed.

11. Applicant's amendment necessitated the new ground(s) of

rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pak, whose telephone number is (703) 305-7038. The examiner can normally be reached on Monday through Friday from 9:30 AM to 6:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lila Feisee, can be reached on (703) 308-2731.

Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

MOP

Michael Pak
Patent Examiner
1646
16 November 1998



LILA FEISEE
SUPERVISORY PATENT EXAMINER